REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 24-52 and 54 are pending in this case. Claims 24, 27, 47, and 54 are amended by the present amendment. The changes to Claims 24, 27, 47, and 54 are supported by the originally filed disclosure at least at paragraphs [0060], [0082], [0083], and [0088] to [0090] of the published Specification. Thus, no new matter is added.

In the outstanding Office Action, Claims 24-27, 29, 30, 32-36, 38, 43, 45-50, 52, and 54 were rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi (U.S. Pub. No. 2002/0141380) in view of Levin, et al. (U.S. Pub. No. 2002/0149784, herein "Levin"); Claims 28, 31, 39-42, 44, and 51 were rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi in view of Levin, further in view of Ben-Chorin, et al. (U.S. Patent No. 7,352,488, herein "Ben-Chorin"), and Claims 37 was rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi in view of Levin, further in view of Kajita, et al. (U.S. Patent No. 6,069,706, herein "Kajita").

Applicants respectfully traverse the rejections of pending Claims 24-52 and 54.

Amended Claim 24 recites an **image processing apparatus comprising** , *inter alia*, "a **format converter** that **converts** the **first format** of the image data stored **to a second format** that is compatible with an external device **based on predetermined conditions set in the image processing apparatus.**"

The outstanding Office Action asserts Koguchi as teaching every element of Claim 24 except a memory and a printer engine as defined by Claim 24, which it asserts Levin as teaching.

However, the combination of Koguchi and Levin fails to teach or suggest at least the above-quoted features of amended Claim 24.

The description of <u>Koguchi</u>, at paragraphs [0088] to [0103], clarifies that a setting screen 80, depicted at Fig. 9, is displayed to a user at a PC 32, connected to the data transmission apparatus 10, which is asserted to teach the image processing apparatus as defined by Claim 1, over the internet N. The user at the PC 32 specifies a file format to the data transmission apparatus 10 for image files emailed to the PC32.

Thus, <u>Koguchi</u> fails to teach or suggest "a **format converter** that **converts** the **first format...to a second format** that is **compatible with an external device...based on predetermined conditions <u>set in the image processing apparatus</u>**." Instead, <u>Koguchi</u> describes a **user** specifying the second format **at the external device**.

<u>Levin</u> fails to cure the above-discussed deficiencies of <u>Koguchi</u> with regard to Claim 24 and is not asserted to teach the format converter as defined by Claim 24.

Finally, although the issue of the propriety of the proposed combination need not be addressed in this case because, even in combination, the cited references fail to teach every feature of Claim 24, the asserted combination is discussed briefly for completeness.

<u>Koguchi</u> specifically states, at paragraph [0076], that "image data obtained in step S103 is stored...without undergoing any image processing." At paragraphs [0080] to [0085], <u>Koguchi</u> describes that the stored image data is either (a) sent as an HTML file via an intranet to a recipient who also has a conversion options screen displayed or (b) converted by the sender and sent as an e-mail via the internet.

The assertion in the outstanding Office Action that it "would have been obvious...to combine Koguchi with Levin to add converting from RGB to CMYK before storing...to prepare data for printing" has no rational underpinning based on <u>Koguchi</u>, when considered as a whole as required by MPEP § 2141. Image data in <u>Koguchi</u> is either sent as an HTML file, to be converted by its recipient, or is converted as determined by a sender and sent in an

e-mail. The outstanding Office Action has not proffered a proper motivation to modify

Koguchi as asserted and, therefore, has not established a *prima facie* case of obviousness.

The Court recently reiterated the requirement for asserting a proper motivation under

MPEP § 2143.01 by stating that a "patent composed of several elements is not proved

obvious merely by demonstrating that each element was, independently, known in the prior

art." KSR Int. Co. v. Teleflex Inc., 82 USPQ2d 1385, 1389 (2007). The Court noted,

quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006)), "there must

be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness" (emphasis added).

Because Koguchi and Levin are not properly combined and because, even in

combination, Koguchi and Levin fail to teach or suggest at least the above-discussed features

of Claim 24, Applicants respectfully request that the rejection of Claim 24 under 35 U.S.C. §

103(a) be withdrawn.

Claims 47 and 54, though differing in statutory class and scope from Claim 24,

patentably define over the combination of Koguchi and Levin for similar reasons as those

discussed above with regard to Claim 24. Thus, Applicants respectfully request that the

rejection of Claims 47 and 54 under 35 U.S.C. § 103(a) be withdrawn.

Claims 25-46 depend from Claim 24, and Claims 48-52 depend from Claim 47. Thus,

Claims 25-46 and 48-52 patentably define over the combination of Koguchi and Levin for at

least the same reasons as Claims 24 and 47. Further, Ben-Chorin, which is additionally

asserted against Claims 28, 31, 39-42, 44, and 51, and Kajita, which is additionally asserted

against Claim 37, do not cure the deficiencies of the combination of Koguchi and Levin with

regard to Claims 24 and 47 and, further, are not asserted for the above-discussed features that

are deficient in the combination of Koguchi and Levin.

Additionally, Claims 25-26 and 48-52 define additional features that are also deficient in the cited references.

For example, amended Claim 27 clarifies that "the **format converter** includes a compressor that compresses the image data stored and an expandor that expands the compressed image data stored in the first format, and the format converter **expands the compressed image data stored in the first format and converts to the second format**."

The outstanding Office Action asserts <u>Levin</u> as teaching the memory as defined by Claim 24. <u>Levin</u> does depict, at Fig. 2A, and describe, at paragraph [0015], that scan data is compressed. However, <u>Koguchi</u> is completely silent regarding compression or expansion.

The outstanding Office Action asserts the mention of JPEG format, which is a compression format, in <u>Koguchi</u> as teaching that stored data is compressed. However, Claim 27 is amended to clarify that compressed data is stored and expanded for conversion.

Claim 49 patentably defines over the combination of <u>Koguchi</u> and <u>Levin</u> for similar reasons as those discussed with regard to Claim 27.
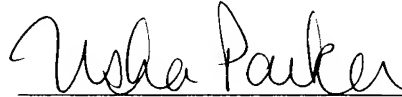
Thus, Applicants respectfully request that the rejections of Claims 25-46 and 48-52 under 35 U.S.C. § 103(a) be withdrawn.

If any of the rejections in the outstanding Office Action are maintained in a subsequent Action, Applicants request that the arguments above be specifically addressed, as required by MPEP § 707.07(f).

Accordingly, the outstanding rejections are traversed and the pending claims are

believed to be in condition for formal allowance. An early and favorable action to that effect

is, therefore, respectfully requested.

Respectfully submitted,

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